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DECISION ON PETITION

In re Application of
Michael Anthony Kawecki, et al.
Application No. 08/991,281
Filed: December 16, 1997
Attorney Docket No. Kawecki 3-3

This is a decision on the petition under 37 CFR 1.181(a), filed April 21, 1999, to withdraw the holding of abandonment for the above-identified patent application.

The petition is **granted**.

This application was held abandoned for failure to respond to the Notice to File Missing Parts of Application - Filing Date Granted (Notice) mailed March 27, 1998. The Notice set a period for response of two month from the mailing date of the Notice. No response having been received by the Office within this two month period, the application was held abandoned on May 28, 1998. A Notice of Abandonment was mailed on April 9, 1999.

Petitioner contends that the response to the Notice was timely mailed to the Office on April 9, 1998. To support this contention, petitioner has included a copy of the postcard receipt date stamped April 15, 1998 which includes the following documents: Petition to Correct Inventorship, Statement of Added Inventor, Declaration and Power of Attorney, and PTO-1533 Notice to File Missing Parts.¹ A copy of each of these documents was submitted with the instant petition. Based upon this showing, petitioner's contention is found to be valid and the holding of abandonment for failure to respond to the Notice to File Missing Parts of Application is withdrawn.

Petitioner is informed that the Petition to Correct Inventorship Pursuant to 37 CFR 1.48(a) is not necessary in this case. While a Petition to Correct Inventorship would have been necessary under former Rule 48, it is no longer necessary under current Rule 48. Section 201.03 of the Manual of Patent Examining Procedure (MPEP) explains the difference between current and former 37 CFR 1.48(a) as follows:

¹ Since none of these documents bear a certificate of mailing under 37 CFR 1.8, they do not receive the benefit of the alleged April 9, 1998 date of mailing, instead, they get the benefit of the April 15, 1998 filing date on the submitted return postcard receipt.

The Office will issue a filing receipt listing the inventors identified at the time of filing of the application even if the application was filed under 37 CFR 1.53(f) without an executed oath or declaration. Where the first-filed executed oath or declaration was filed **on or after December 1, 1997** and sets forth an inventive entity which is different from the inventive entity initially set forth at the time of filing of the application, the actual inventorship of the application will be taken from the executed oath or declaration. See 37 CFR 1.41(a)(1). A petition under 37 CFR 1.48(a) will **not** be necessary. See 37 CFR 1.41(f)(1).

Where the first-filed executed oath or declaration was submitted **prior to December 1, 1997** in an application filed without an executed oath or declaration, if the inventive entity identified on the executed oath or declaration differs from the inventive entity identified at the time of filing of the application, a petition under 37 CFR 1.48(a) or (c) must also be submitted. Upon the grant of the petition under 37 CFR 1.48 by the primary examiner, the application will be returned to the Office of Initial Patent Examination (OIPE) for the mailing of a corrected filing receipt.

MPEP, 7th Edition, pp. 200-4 to 200-5 (July 1998).

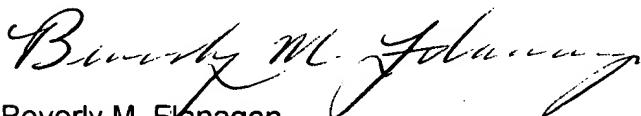
Since petitioner submitted the first executed oath or declaration on April 15, 1998, it is clear that the instant application is subject to the provisions of current Rule 48. Accordingly, petitioner need not submit a petition under 37 CFR 1.48(a) in order to correct the inventorship on this application. Thus, based upon current Rule 48(a), the executed Declaration and Power of Attorney filed with the instant petition and date-stamped April 21, 1999 has been entered into the application file and made of record.

The Associate Power of Attorney filed on August 18, 1999 has been approved and entered into the record for this application.

Because no fee is associated with this petition, the \$130.00 petition fee authorized on April 21, 1999 is being refunded to Deposit Account No. 01-2745.

This application file is being forwarded to the Office of Initial Patent Examination for pre-examination processing (which will include changing the inventorship for this application and issuing a new filing receipt) and for assignment of this application to a Technology Center.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Karen Canaan at (703) 306-3313.



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